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DEC 14 2007

OFFICE OF PETITIONS

In re Application of	:	
Andrys et al.	:	Decision Refusing to Accord
Application No. 10/691,115	:	Status Under 37 CFR 1.47(a)
Filed: October 21, 2003	:	
Attorney Docket No. SK00002C1	:	

This is a decision on the petition under 37 CFR 1.47(a), filed April 26, 2004.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. No further petition fee is required for the request. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)." **Failure to respond will result in abandonment of the application.**

When a parent application has been accorded status under 37 CFR 1.47, an applicant may submit a copy of the declaration from the parent application and a copy of the parent application's Rule 47 decision letter instead of submitting a new petition under 37 CFR 1.47.¹

Petitioner has supplied a copy of the declaration from Application No. 09/693,398. However, petitioner has not supplied a copy of a decision granting the petition under 37 CFR 1.47 filed in Application No. 09/693,398.

Even if the petition included a copy of the decision from Application No. 09/693,398, the declaration could not be accepted pursuant to 37 CFR 1.47(a). Although petitioner clearly intends for the instant application to be a continuation application, the instant application is not legally a continuation application.

¹ 37 CFR 1.63(d)(3) states, "Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration for such prior application must be accompanied by . . . A copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit."

Since the instant application was filed on or after November 29, 2000, to be valid and proper, a priority claim must be included in an Application Data Sheet or the first sentence of the specification must contain, or be amended to contain, the priority claim. A review of the electronic file wrapper fails to indicate an Application Data Sheet has been filed. The first sentence of the specification is an improper, incomplete claim for priority. The first sentence of the specification states, "This application claims the benefit of U.S. Provisional Application No. _____, entitled "Configurable Power Amplifier Bias Control," filed October 6, 2000, that is incorporated by reference."

The Office recommends petitioner file a Request for Reconsideration under 37 CFR 1.47 along with a copy of the decision on petition from Application No. 09/693,398.

In addition to the Request for Reconsideration, petitioner *may* need to file a petition under 37 CFR 1.78. Per 37 CFR 1.78(a)(3)(ii), an applicant must file a proper priority claim within the later of four months from the actual filing date of the instant application or sixteen months from the filing date of the prior application. Petitioner failed to comply with the deadline to submit a proper priority claim.

Despite the failure to timely file a priority claim, a petition under 37 CFR 1.78 is unnecessary in order to add a priority claim based *only* on Application No. 09/693,398. While a reference to Application No. 09/693,398 was not included in an Application Data Sheet (ADS) or in the first sentence of the specification, a reference, nevertheless, was made in the transmittal letter filed with the application. Where a claim for priority under 37 CFR § 1.78(a)(3) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority.² On the other hand, if the USPTO does not note the claim for priority to the prior-filed applications set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR § 1.78(a)(3). In the present case, the Office noted the claim for priority to Application No. 09/693,398 in the transmittal letter filed with the application, as shown by its inclusion on the original filing receipt. Petitioner may add the priority claim by filing an amendment or ADS in compliance with 37 CFR 1.312 prior to, or at the same time, as filing the issue fee. If the amendment or ADS will not comply with 37 CFR 1.312, a RCE must also be filed. In order to add the claim for priority after the issue fee is paid, petitioner must either file a petition to withdraw the application from issuance, or file a request for a certificate of correction after the patent has issued.

The original filing receipt did not include the priority claim to Provisional Application No. 60/238,846. Therefore, a petition under 37 CFR 1.78 must be filed in order to add a priority claim to Application No. 09/693,398 **and** to Provisional Application No. 60/238,846. If the petition is filed prior to payment of the issue fee, then the priority claim must be filed as part of an amendment or ADS in compliance with 37 CFR 1.312. If the amendment or ADS does not comply with 37 CFR 1.312, a RCE must also be filed. If the petition is filed after payment of the issue, petitioner should also file a petition to withdraw the application from issuance along with a RCE. **Petitioner should note, once the patent issues, the priority claim under 35 U.S.C.**

² Note MPEP 201.11 (III)(D) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

§ 119(e) cannot be corrected by the filing of a Certificate of Correction.


Any request for reconsideration and/or petition under 37 CFR 1.78 should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3230.


Shirene Willis Brantley
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Office of Petitions